

Ser. No. 09/596,362
Amendment after Final

REMARKS

Applicant is proposing to amend the abstract by omitting the objectionable characterization of a method of the invention as being "novel". A reference to non-alcoholic beer was re-inserted into abstract to more accurately reflect the scope of the disclosure set forth in the specification.

In the final office action issued April 24, 2002, the Examiner rejected claim 1 pursuant to 35 U.S.C. § 102, for the reason that claim was clearly anticipated by Chatterjee et al, (DE 1987134; hereafter '134).

35 U.S.C. § 102 provides that a person **shall** be entitled to a patent **unless**

(a) the invention was . . . patented or described in a printed publication in this or a foreign country, **before the invention thereof by the applicant . . . ; or**

(b) the invention was patented or described in a printed publication in this or a foreign country . . . **more than one year prior to the date of application** for patent in the United States; or

* * *

(e) the invention was described in a patent granted . . . on an international application by another . . . **before the invention thereof by the applicant . . . (for Pre -PG PUB Applications)**

When applying 35 U.S.C. §§(a), (b) and (e), the effective filing date of the application must be determined and compared with the date of the reference. MPEP § 706.02(a).

The effective filing date of the subject application is the filing date of the provisional application upon which the present application is based. Invention occurs upon conception and reduction to practice. Filing an enabling disclosure constitutes constructive reduction to practice. *Broos v. Barton*, 142 F.2d 690, 692 (Cust. & Pat. App. 1944). The provisional application filed **June 29, 1999**, is an enabling disclosure that supports the claims made in the later filed formal

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application and, therefore constitutes Applicant's date of invention.¹ The applicable date for Chatterjee et al., '134, is April 20, 2000, its publication date. MPEP § 2127; *In re Wyer*, , 665 F.2d 221, 210 USPQ 790 (CCPA 1981).

Applicant's date of invention through constructive reduction to practice precedes the publication date for Chatterjee.² Accordingly, Chatterjee does not anticipate the subject matter claimed and taught by independent claim 1 and does not defeat the novelty of that claim. See, e.g., MPEP § 706.02(b).

Independent claim 7, and claims 8 and 9 dependent thereon, have been deleted for purposes of this after final reply.

Pending claims 2 through 6, and newly proposed claims 10 through 12, include all limitations found in independent claim 1 and, accordingly, are new and obvious for the same reasons as claim 1.

¹ Applicant is entitled to establish an earlier date of invention using extrinsic evidence. By relying upon the date of filing for constructive reduction to practice for purposes of this reply, Applicant does not intend to waive its right to establish an earlier date of actual reduction to practice in some later proceeding on this same invention.

² There is no evidence that Chatterjee, '134, ever ripened into a patent and, in particular, ripened into a U.S. patent on a PCT application meeting the requirements of 102(e) for Pre-PG PUB Applications.

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AMENDMENT (MARKED UP VERSION)

CLAIMS:

10. (new) The method of claim 1 wherein said anticraving composition is administered orally by way of a non-alcoholic wine beverage.

11. (new) The method of claim 1 wherein said anticraving composition is administered orally by way of a non-alcoholic beer beverage.

12. (new) The method of claim 1 wherein said anticraving composition is administered orally by way of a distilled spirit beverage in regard to which the alcohol has been removed and replaced by kavapyrones.

ABSTRACT:

Administered anticraving compositions are disclosed for treating patients addicted to alcohol comprising an effective amount of at least one alpha-pyrone compound formulated into a physiologically acceptable carrier medium. Additionally, a [novel] method of oral administration of the anticraving compounds is disclosed where an effective amount of at least one alpha-pyrone compound is formulated into a wine, beer or [a]distilled spirit where the alcohol has been removed and replaced by one or more kavapyrones.

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CONCLUSION

Applicant is proposing to amend the abstract to remove the objectionable language and to amend those claims that concern methods of administration using non-alcoholic beverages to depend upon claim 1. Having established that Chatterjee ('134) does not anticipate the subject invention, Applicant is entitled to a patent on the subject matter claimed in claim 1. Claims 2 through 6 and 10 through 12 include all limitations found in claim 1 and should, therefore, likewise be allowed.

The Examiner is invited to contact the undersigned attorney at (808) 544-8351, business hours Hawaii standard time, or via email at [<sreiss@wik.com>](mailto:sreiss@wik.com), in order that the undersigned attorney may endeavor to resolve any outstanding issues as expeditiously as possible thereby to avoid prolonged prosecution of the present application.

The proposed amendment after final, and the remarks supplied therein, do not raise new issues or evidence and merely apply the law to matters already of record in this case. The proposed amendments and remarks were not provided earlier because Applicant, not having had the benefit of counsel, did not appreciate the significance of his priority being earlier than the publication date of '134 patent. A power of attorney form authorizing the undersigned representative to submit this communication and further prosecute this Application on Applicant's behalf is being submitted together herewith. This reply after final is being submitted as soon as practicable after Applicant's representative received this case.

The proposed amendment and remarks are being faxed and mailed with a certificate within two months of the mailing date of the April 24, 2002 final office action. The number of

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independent claims and the total number of claims, after amendment, are within the number paid for with the filing fee.

Respectfully submitted,



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